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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/660,527	09/12/2003	Tetsuro Motoyama	241499US2CONT	5289
22850	7590	07/07/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	

DATE MAILED: 07/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/660,527

Applicant(s)

MOTOYAMA ET AL.

Examiner

Prieto Beatriz

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to Request for Continued Prosecution filed 05/11/05, claims 1, 5 and 9 have been amended, claims 1-15 remain pending.

2. Information Disclosure Statement (IDS) under 37 CFR 1.97 filed 04/22/05, comprising a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application. These are not provided on PTO-1449, PTO/SB/08A or 08B, or PTO/SB/42 (or on a form having a format equivalent to one of these forms), that provide a space to the examiner to initial, signed and date.

3. Regarding claim 1 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 6 of U.S. Patent No. 6,631,247 (referred to as patent '247 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262.

Terminal disclaimer filed 4/13/05 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of patent 6,631,247 has been reviewed and is accepted. The terminal disclaimer has been recorded, rejection is withdrawn.

4. Quotation of non-statutory double patenting rejection based on a judicially created doctrine may be found in previous office action.

5. Claims 1 and 3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,544,289 (referred to as patent '289 hereafter) in view of Barrett et. al. U.S. Patent No. 5,935,262. Although the conflicting claims are not identical, they are not patentably distinct from each other because instant application is an obvious variation of the '289 patent.

6. Claims 1 and 3 of the application has substantially the same substance of claim 1 of the '289 patent. Both the application and '289 patent in substance transfer information in a copier to a computer, where the information changes with time. The difference between the application and the patent is that in

the application a determination as to whether to transfer to the second computer is made, in instant application a report is periodically generated for transmission to a computer. The noted difference between the conflicting claims is not suffice to render the invention of claims 1/3 of the application patentably distinct and/or therefore substantially the same invention and/or a mere obvious variation of the patent '289.

Barrett teaches the transmission of log file information based on a predetermined condition including inter alia when a predetermined time has been met, thereby periodically transmitting information to a computer (col 2/lines 11-26), the information including status information (col 25/lines 47-55), the processing and formatting in response to said predetermined condition obtained status information to generate report (Fig. 29 and col 35/lines 16-50). It would have been obvious to one ordinary skilled in the art at the time the invention to periodically process and format status information for transmission to a computer by the device itself or by a computer as discussed by Barrett enabling the periodic transmission of status information base on predetermined condition such as when sufficient information is available or a memory capacity has been met, upon demand or in response to a predetermined time being met, set forth by Barrett.

Claim Rejection under 35 U.S.C. 103

7. Quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
8. Claim 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et. al. U.S. Patent No. 5,897,236 (Hashimoto hereafter) in view of Tarr et. al. U.S. Patent No. 5,184,179 (Tarr hereafter).

Regarding claims 1, 5 and 9, Hashimoto discloses features of the invention as claimed, including as shown in Fig. 4, a network device (1) communicatively coupled to a network, comprising:

obtaining by a first computer (18) status information of the network device (col 8/lines 66-col 9/line 4), including information obtained from sensors of the network device (col 8/lines 36-40), information including usage information (col 9/lines 5-10, col 10/lines 51-54 and Figs. 14A and 14B) and including device identification (col 10/lines 20-31);

storing the obtained device status information at the first computer (col 1/lines 1-4, col 2/lines 1-9);

processing the stored status information to generate a collection of said information (called "usage report") for the network device, processing including selecting predetermine data (col 7/lines 40-57) for producing the remote report (col 10/lines 29-31), and updating stored information (see col 9/lines 26-67);

transmitting the usage report from the first computer to a second computer (col 9/lines 48-67);
and

receiving the usage report by the second computer from the first computer (col 15/lines 60-63);
however Hashimoto does not teach where the network device and the first computer communicate over a network.

Tarr teaches a first computer at a remote site from a network device obtaining information there from (col 9/lines 35-57), wherein the first computer to obtain the device information from the at least one network device communicated with the network device over a network (e.g. local area network) between the first computer and the network device (col 9/line 58-col 10/line 4), the first computer configured to generate report for transmitting to a second computer (col 11/lines 17-26), including processing (e.g. evaluating) received information for generating report for transmission (col 12/lines 11-54).

It would have been obvious to one ordinary skilled in the art at the time the invention was a made given the teachings for accessing status information from a network device for transmitting to a remote computer, the teachings of Tarr for obtaining status information from remote copiers would be readily apparent. Motivation would be to retrieve status information from a plurality of copiers using only an external telephone line.

Regarding claim 2, transmitting the usage report to the second computer at a predetermined time or upon the occurrence of a predetermined event (col 9/lines 14-59 and col 10, lines 5-19).

Regarding claim 3, the network device is a copier (Figs. 15A-B), and the usage report includes a number of copies made by the copier over a predetermined period (col 9/lines 7-18).

Regarding claims 6-7, these system claims are substantially the same as the method claims 2-3, discussed above, same rationale of rejection is applicable.

Regarding claims 10-11, these computer program product claims are substantially the same as the method claims 2-3 and the system claims 6-7, discussed above, same rationale of rejection is applicable.

9. Claims 4, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Hashimoto in view Tarr in further view Danknick et. al. U.S. Patent No. 5,901,286 (Danknick hereafter)

Regarding claims 4, 8 and 12, however the Hashimoto reference does not teach the use of HTML or Excel formats in its usage reports;

Danknick discloses as prior art accessing a network device by a computer to obtain the network device's status information including converting the obtained status information to an HTML format (col 1/lines 45-48), furthermore teaching relocatable software executing on a computer configured to translate information regarding status information associated with usage in a network device into a HTML format for rendering as a web page (col 10/lines 30-36) or other formats (col 12/lines 42-48).

It would have been obvious to one ordinary skilled in the art at the time the invention was made given the teachings of Hashimoto for monitoring a network device by accessing its status information a including displaying the obtained data received via modem telephone based network to include supporting the access to network device status information via a telephone network, motivation would be to further enhance Hashimoto's system with existing technology such as high speed digital lines, e.g. high speed integrated digital network (ISDN) telephone lines enabling Web based monitoring functions as set forth by Danknick.

Regarding claims 13-15, report is generated on a monthly or weekly basis (Hashimoto: monthly basis col 9/lines 48-67, generating for transmission one a month col 15/lines 36-45).

10. Claim 1, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over by Barrett et. al. U.S. Patent No. 5,935,262 (Barrett et. al).

Regarding claims 1, 5 and 9, Barrett discusses as prior art;

accessing a network device by a first computer to obtain device status information of the network device, including information obtained from detector or counter ("sensors") of the network device (col 1/lines 44-50), wherein the first computer is remote from the network device (col 1/lines 51-65), wherein the first computer obtains device information over a LAN (col 1/lines 40-50);

storing the obtained device status information for further processing (col 1/lines 51-55); processing the stored status information to generate a ("usage report") collection of information for the

network device (col 1/lines 51-55), processing formatting obtained information to generate report, col 16/lines 25-40, col 12/lines 28-38);

transmitting the usage report from the first computer to a second computer (e.g. remote PC) (col 1/lines 51-55); and receiving the usage report by the second computer (col 1/lines 51-55), although the collection of status information generated in the Barrett's reference is not denoted "period usage report" it comprises the same features as claimed.

It would have been obvious to one ordinary skilled in the art at the time the invention was made to perform task periodically motivated by Barrett's disclosure for example, to periodically process the status information according to maintenance or billing cycle for which the status information is obtained and used for, as disclosed by Barrett.

Response to Arguments

11. Regarding claims 1, 5 and 9 rejected under 35 USC 103 as being unpatentable over Hashimoto view of Tarr it is argued (p. 8-9 or remarks) applied prior art teaches all of the claim 1, except added limitation. Specifically, the applied references do not teach "the first computer is the first computer to obtain the device information from at least one network device". Because in the Hashimoto reference the control device (18) is inserted in the user's existing communication line and in the Tarr reference the computer control (16) is directly connected to the copier.

In response to the above-mentioned argument, applicant's interpretation of the applied references has been fully considered. However, Tarr discloses that "By providing a *local area network between the computer control (16) circuit and the copier*, it becomes possible to monitor a plurality of copiers while tying up only a single external telephone line saving telephone time and telephone space" (column 9, lines 65 to column 10, line 4). Arguments that the computer control (16) is directly connected to the copier are not persuasive.

12. Regarding claims 1, 5 and 9 rejected under 35 USC 103 as being unpatentable over Hashimoto view of Tarr it is argued (p. 8-9 or remarks) applied prior art teaches all the limitation of claim 1 except added limitation. Specifically, the applied references do not teach "generate a period usage report for the at least one network device". Because according to applicant, Hashimoto discloses a "total counter value", the counter detector (18) counts the number of pages processed and transmits that count to the computer control 16, but the computer control (46) (it seems applicant intended refer to 16 as the

computer control's reference number) is not the first computer to obtain the device information from the copier over the network.

In response to the above-mentioned argument, applicant's interpretation of the applied references has been fully considered. However, Tarr discloses that "By providing a *local area network between the computer control (16) circuit and the copier*, it becomes possible to monitor a plurality of copiers while tying up only a single external telephone line saving telephone time and telephone space (column 9, lines 65 to column 10, line 4). Arguments that the computer control (16) is not the first computer to obtain information from the copier over a network, is not persuasive.

13. Regarding claim 1 rejected under 35 USC 103 as being unpatentable over Barrett, it is argued (p. 10 of remarks) the applied prior art fails to teach claim limitation as amended. Specifically, Barrett fails to teach over a network, because the network expansion device (NED)(1001) is not remote from the printer instead it is directly connected to the network device, as noted on column 1, lines 51-65, according to applicant.

In response to the above-mentioned argument, applicant's interpretation of the applied prior art has been fully considered. However the cited portion reads: The log file maintained by the network device is conventionally *accessed using a computer. The computer can retrieve the log file via the LAN* and can format and display or print the log file or save the log file to a disk on a remote PC and then print the log file. Thereby, Barrett discloses obtaining by a first computer over a network, device information of at least one network device, the device information including status information. The computer used to access the log file is the first computer to obtain the device information from the at least one network device (column 1, lines 51-65). The status information operational parameters and the like (column 1, lines 35-36), information related to image forming jobs received and the output to the image forming apparatus, statistical information related to the operation of the network device and/or status information and usage information for generating bills for the use of the network device, its maintenance or re-supply of resources used therein or diagnosing information (column 1, lines 40-50).

Hence, the applied prior art teaches accessing a network device by a first computer to obtain device status information of the network device, stored information used to generate a period usage report for the network device, the first computer is remote from the network device and the first computer to obtain the device information from the network device.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be

reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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Faxed to the Central Fax Office:
(703) 872-9306 (old No. in service until Sept. 15, 2005),
(571) 273-8300 (New Central Fax No.)

Or Telephone:

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B. Prieto
TC 2100
Primary Examiner
July 6, 2005


BEATRIZ PRIETO
PRIMARY EXAMINER